

ADMINISTRATIVE PANEL DECISION

PrideStaff, Inc. v. Registration Private, Domains By Proxy, LLC / Shagun Duggal, Pridestaffing
Case No. D2022-2910

1. The Parties

The Complainant is PrideStaff, Inc., United States of America (“United States” or “US”), represented by Frost Brown Todd LLC, United States.

The Respondent is Registration Private, Domains By Proxy, LLC, United States / Shagun Duggal, Pridestaffing, India.

2. The Domain Name and Registrar

The disputed domain name <pridestaffings.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 6, 2022. On August 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 9, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on August 11, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on August 16, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 6, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 12, 2022, to which the Respondent replied with an informal communication to the Center on September 12, 2022.

The Center appointed John Swinson as the sole panelist in this matter on September 23, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a corporation from California, United States. The Complainant was founded in 1978 and is in the business of providing professional staffing services for both employers with professional staffing needs and individuals looking for job placement services. The Complainant has over 80 offices in the United States. The Complainant's primary domain name is <pridestaff.com>, which was registered in 1996.

The Complainant owns United States Trademark Registration No. 2,116,589 for PRIDESTAFF, in International Class 35, registered from November 25, 1997.

The Respondent did not file a formal Response, but sent an email communication to the Center claiming to have legally registered an entity under the name PrideStaffing LLC. The Registrar's records show that the Respondent has an address that is near Delhi, India.

The Complainant was successful in a prior domain name dispute against the Respondent, involving the domain name <pridestaffing.in>. See .IN Domain Name Dispute Resolution Policy ("INDRP") Case No: 1489, *Pridestaff, Inc. vs Shagun Duggal* decided on February 23, 2022.

The disputed domain name was registered on March 2, 2022.

The decision in the INDRP case referred to above states:

"On December 8, 2021 Complainant received a response to its communication from the email address <XXX@pridestaffing.in> purporting to be on behalf of 'Pridestaffing LLC' and stated that Respondent has been registered with 'Harvard Business Services', a corporate services company in the United States. The email admitted that Respondent has been working with clients in the U.S. market. Complainant researched the so-called 'Pridestaffing LLC' and found its LinkedIn profile, which states that Pridestaffing LLC offers services in the U.S. and lists numerous employees as located in various cities in the U.S."

Moreover, that decision included reference to evidence that the Respondent had created a website at "pridestaffing.in" that gave a false physical address for the Respondent in New Jersey, United States.

At the present time, the disputed domain name resolves to a registrar-generated parking page.

The Registrar's records show that MX-records have been set up for the disputed domain name, allowing the Respondent to send and receive emails using the disputed domain name.

5. Parties' Contentions

A. Complainant

The Complainant owns a registered trademark for PRIDESTAFF, referred to above. This trademark has been in use in the United States since March 1, 1995.

The Complainant is well-known in the staffing industry and its PrideStaff Services have received numerous independent awards and recognitions from unrelated third parties, showcasing the strength and value of the PRIDESTAFF trademark.

The disputed domain name is confusingly similar to the PRIDESTAFF Mark as it incorporates the PRIDESTAFF trademark in its entirety. The changing of “staff” to “staffings” does nothing to obviate the impact of this incorporation, as it provides the same commercial impression and is virtually the exact same trademark.

The Complainant asserts that the Respondent is neither a franchisee nor otherwise affiliated with the Complainant. The Complainant also states that the Respondent is not doing business as “Pridestaff” or “Pridestaffings”. Rather, according to the Complainant, the Respondent is using the disputed domain name for illegitimate purposes, which do not equate to a *bona fide* offering of services in connection with the disputed domain name.

The Respondent is passively holding the disputed domain name and is preventing the Complainant from obtaining its rightful ownership and control of the disputed domain name.

The Respondent has set up MX-records for the disputed domain name. This allows the Respondent to send and receive emails from the disputed domain name such as “[...]@pridestaffings.com”, indicating that disputed domain name may be used for fraudulent email communications. Because the Respondent’s use of the disputed domain name would imply an affiliation with the Complainant, the Complainant is not required to show that the Respondent has sent communications. In this situation, it is sufficient to prove bad faith because the Respondent has the ability to send such communications.

This case involves a Respondent who has already been found to lack a legitimate or *bona fide* interest in the PRIDESTAFF trademark for a similar domain name within the country code top-level domain of his home country of residence, namely India, under the INDRP. The Respondent registered the disputed domain name on March 2, 2022, long after the Complainant’s PRIDESTAFF trademark had become a well-known trademark of the Complainant – and shortly after the adverse INDRP decision was issued against the Respondent and his unauthorized use and registration of the domain name <pridestaffing.in>.

B. Respondent

The Respondent did not formally reply to the Complainant’s contentions.

The Respondent sent an email to the Center on September 12, 2022, that stated:

“We are legally Registered and Authorized to work in the United States with the Name of ‘PrideStaffing LLC’. If required, we can legally represent the Article/Certificate of Formation for PrideStaffing LLC as we are registered in a different state.” The Respondent then provided a list of entities sharing a similar name.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The onus of proving these elements is on the Complainant.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that

it deems applicable.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that the Complainant must establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant owns a trademark registration for PRIDESTAFF.

Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy when the domain name includes the trademark, or a confusingly similar approximation. See, for example, *Consumer Reports, Inc. v. Wu Yan, Common Results, Inc.*, WIPO Case No. [D2017-0371](#); and *Captain Fin Co. LLC v. Private Registration, NameBrightPrivacy.com / Adam Grunweg*, WIPO Case No. [D2021-3279](#).

The disputed domain name includes the Complainant's PRIDESTAFF trademark in its entirety, and adds the letters "ings" to the end of the Complainant's trademark.

The Panel concludes that the disputed domain name is confusingly similar to the Complainant's PRIDESTAFF trademark.

The Complainant succeeds on the first element of the Policy.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant.

Previous UDRP panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden of production will shift to the respondent to rebut that *prima facie* case.

The Complainant asserts that the Respondent is neither a franchisee nor otherwise affiliated with the Complainant. The Complainant also states that the Respondent is not doing business as "Pridestaff" or

“Pridestaffings”. Rather, according to the Complainant, the Respondent is using the disputed domain name for illegitimate purposes which do not equate to a *bona fide* offering of services in connection with the disputed domain name.

The Panel finds that the Complainant has established a *prima facie* case under the second element.

The Respondent had the opportunity to come forward and present evidence that he has rights or legitimate interests in the disputed domain name. The Respondent has not done so.

There is no evidence before the Panel to show that the Respondent has a legitimate business called “PrideStaffings” or similar. The INDRP case referred to above demonstrates otherwise, and in particular, the Panel notes that the disputed domain name was registered shortly after the rendering of the decision in INDRP Case No: 1489, *Pridestaff, Inc. vs Shagun Duggal*, decided on February 23, 2022. The Respondent’s email of September 12, 2022 is not evidence sufficient under the Policy to show that the Respondent has rights or legitimate interests in the disputed domain name. A mere assertion is not evidence. In addition, even if the Respondent had incorporated such entity, the Panel does not consider that the fact of adopting such corporate name is in itself sufficient to establish rights or legitimate interests in the disputed domain name for the purposes of the Policy. There is no evidence the Respondent has been commonly known by the disputed domain name within the meaning of paragraph 4(c)(ii) of the Policy. In this case, the Panel notes the similarity between PRIDESTAFF and “Pridestaffings”, despite the Respondent’s claims that these are (sufficiently) different. In the circumstances of the case, the Panel finds more likely than not the Respondent adopted deliberately a disputed domain name similar to that of the Complainant and its trademark, probably with a view to taking unfair advantage of the similarity with the Complainant’s trademark.

The Complainant succeeds on the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and subsequently used the disputed domain names in bad faith.

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by the complainant. *Fifth Street Capital LLC v. Fluder (aka Pierre Olivier Fluder)*, WIPO Case No. [D2014-1747](#).

The Respondent was clearly aware of the Complainant and the PRIDESTAFF trademark when the disputed domain name was registered. The Respondent was unsuccessful in an INDRP case involving the Complainant, in which the Respondent was provided with evidence of the Complainant’s trademark rights. Soon after receiving an unfavorable decision in that INDRP case, the Respondent registered the disputed domain name.

The Respondent’s registration of the disputed domain name after being unsuccessful in an INDRP case involving a similar domain name is clear bad faith registration.

The disputed domain name is not being used for a website. However, the evidence before the Panel is that the Respondent has configured the disputed domain name for the sending of emails, and noting the composition of the disputed domain name, the Respondent may take unfair advantage of the similarity between the disputed domain name and the Complainant’s trademark. Without explanation from the Respondent, this is bad use of the disputed domain name for the purposes of the Policy. See *bioMérieux v. Registration Private, Domains By Proxy, LLC / Milton Bardmess* WIPO Case No. [D2020-3499](#).

The Complainant succeeds on the third element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <pridestaffings.com> be transferred to the Complainant.

/John Swinson/

John Swinson

Sole Panelist

Date: October 8, 2022